

REMARKS

By this amendment, claims 2, 4, 8-10, 13-17 and 21-29 remain canceled. In addition, claims 1, 3, 6 and 11 have been amended. Claims 1, 3, 5-7, 11, 12 and 18-20 remain in the application. Support for the amendments can be found in the specification and drawings. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, and allowance of the application, as amended, is requested.

Rejection under 35 U.S.C. §103

Claim 1 recites a method to facilitate a programming of a control device that provides a graphic user interface, the method comprising:

enabling a determination of at least one appliance or collection of appliances for being user-controlled through the control device;

determining code for graphically representing controllable features of the at least one appliance or collection of appliances on the graphic user interface of the control device, wherein the graphic user interface includes selectable buttons, icons, clusters of icons, and templates that enhance a control of one or more appliance and need not be appliance specific, wherein determining the code includes extracting as a function of a synergistic control, a device control profile (i) specific to the one or more appliance and (ii) which identifies a nature of the graphic user interface, further in dependence upon at least one of: a location parameter representing a location of the at least one appliance or collection of appliances, a location parameter representing a location of the control device, a location parameter representing a location of a user, a time parameter representing a time of day, a time parameter representing a season of the year, a user profile, and an inventory of appliances of a user; and

communicating the code to the control device for storage at the control device for enabling user-control of the appliance in response to a subsequent user activation of the control device,

wherein determining the code further includes accessing an Internet site in dependence upon the determination of the at least one appliance or collection of appliances.

Support for the amendments to claim 1 (as well as for claim 11) can be found in the specification at least on page 5, lines 9-14; page 6, lines 16-22; page 8, lines 25-27; page 9, lines 23-25. In addition, support for the amendments to claim 3 can be found in the specification at least on page 7, lines 4-6; and page 8, lines 16-17. Furthermore, support for the amendments to claim 6 can be found in the specification at least on page 9, lines 5-7.

Page 2 of the October 16, 2008 Office Action indicates that claims 1, 3-7, 11-12, and 18-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,408,435 to **Sato** (hereinafter "Sato") in view of U.S. Patent 5,410,326 to **Goldstein** (hereinafter "Goldstein"). For clarification purposes, it is noted that claim 4 and claims 21-29 have been previously canceled, thus rendering the rejection thereof moot. Accordingly, this rejection is understood as a rejection of claims 1, 3, 5-7, 11-12 and 18-20 under 35 U.S.C. §103(a) as being unpatentable over **Sato** in view of **Goldstein**.

With respect to claim 1 as amended, Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a *prima facie* case of obviousness for the following reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Sato** and **Goldstein** references cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Sato** nor **Goldstein** teaches "determining code for graphically representing controllable features of the at least one appliance or collection of appliances *on the graphic user interface* ... wherein the *graphic user interface* includes selectable buttons, icons, clusters of icons, and templates that *enhance a control of one or more appliance* and need not be appliance specific, wherein determining the code includes *extracting*, as a function of a *synergistic control, a device control profile* (i) specific to the one or more appliance and (ii) which identifies a nature of the *graphic user interface* ..." as is now claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

In contrast, **Sato** discloses an internet downloaded programmable remote control. In one embodiment, the system of **Sato** includes optimum values of cooling effect by an air conditioner and an optimum value of brightness by an illuminator described as commands in a hypertext using a personal computer (See **Sato** at Col. 9, lines 30-44). However, **Sato** does not teach or suggest "determining code for graphically representing controllable features of the at least one appliance or collection of appliances *on the graphic user interface* ... wherein the *graphic user interface* includes selectable buttons, icons, clusters of icons, and templates that *enhance a control of one or more appliance* and need not be appliance specific, wherein determining the code includes *extracting*, as a function of a *synergistic control, a device control profile* (i) specific to the one or more appliance and (ii) which identifies a nature

of the graphic user interface" as is claimed in claim 1.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. The Combination of References is Improper

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another compelling reason why the **Sato** and **Goldstein** references cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither **Sato** nor **Goldstein** teaches, or even suggests, the desirability of the combination since neither teaches the specific "*determining code for graphically representing* controllable features of the at least one appliance or collection of appliances *on the graphic user interface* ... wherein the *graphic user interface* includes selectable buttons, icons, clusters of icons, and templates that *enhance a control of one or more appliance* and need not be appliance specific, wherein determining the code includes *extracting*, as a function of a *synergistic control*, a *device control profile* (i) specific to the one or more appliance and (ii) which identifies a nature of the graphic user interface ..." as specified above and as claimed in claim 1.

Thus, it is clear that neither patent provides any incentive or motivation

supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination as suggested by the office action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Dependent claims 3, 5-7 and 18 depend from and further limit independent claim 1 and therefore are allowable as well.

Independent claim 11 has been amended herein to include limitations similar to those of claim 1. Accordingly, claim 11 is believed allowable for at least the same reasons as presented herein above with respect to overcoming the rejection of claim 1, and an early formal notice thereof is requested. Dependent claims 12 and 19-20 depend from and further limit independent claim 11 and therefore are allowable as well.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1 and 11 are in condition for allowance. Dependent claims 3, 5-7 and 18 depend from and further limit independent claim 1 and therefore are allowable as well. Dependent claims 12 and 19-20 depend from and further limit independent claim 11 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1, 3, 5-7, 11, 12 and 18-20 is requested.

Respectfully submitted,

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